

REMARKS

Claims 1-11 are pending in this application. Claims 1 and 11 are independent claims. Each of the independent claims 1 and 11 are presently amended.

Entry of Amendments Requested Pursuant to 37 CFR § 41.50(b)(1) and MPEP § 1214.01

On December 18, 2006, the U.S.P.T.O. Board of Patent Appeals and Interferences issued a decision affirming the Examiner's art grounds of rejections with respect to claims 1-4 and 7 under 35 U.S.C. § 102(b) to Premierlani (US 5,958,060) and claims 5, 6, 8-10 under 35 U.S.C. § 103(a) to Premierlani and Thornberg (US 5,757,772). The Board of Appeals entered a new art grounds of rejection in accordance with 37 CFR § 41.50(b) (see pages 5-6 of the Appeal Decision). In the new art grounds of rejection, the Board of Appeals rejected independent claim 11 under 35 U.S.C. § 102(b) as being anticipated by Premierlani. This same rejection was previously withdrawn by the Examiner in the Examiner's answer of October 4, 2005 (see page 2 of the Examiner's answer of October 4, 2005).

MPEP § 1214.01 recites the following:

1214.01 Procedure Following New Ground of Rejection by Board [R-3]

When the Board makes a new rejection under 37 CFR *41.50(b)<, the appellant, as to each claim so rejected, has the option of:

(A) >reopening prosecution before the examiner by< submitting an appropriate amendment and/or **>new evidence (37 CFR 41.50(b)(1))<;

I. SUBMISSION OF AMENDMENT OR **>NEW EVIDENCE<

37 CFR *41.50(b)(1)< provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board

Accordingly, consistent with the provisions of MPEP § 1214.01, Applicant has presently filed an amendment to newly rejected independent claim 11, which will be discussed in greater detail below. Further, Applicant respectfully requests entry of the amendment presently made to independent claim 1. Applicant respectfully submits that the amendment to independent claim 1 is substantially similar to the amendment to independent claim 11. Further, a substantial amount of overlapping subject matter exists within independent claims 1 and 11. Accordingly, in order to expedite prosecution, Applicant respectfully requests that the Examiner enter the amendments to independent claims 1 and 11 and consider the arguments presented below as directed to each of independent claims 1 and 11.

35 U.S.C. § 102(b)

Claims 1-4, 7, and 10-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Premierlani. Applicant respectfully traverses this art grounds of rejection.

The teachings of Premierlani have been discussed in detail both in the prior prosecution of the present application between the Examiner and the Applicant as well as during the subsequent appeal. It was Applicant's position on appeal that implicit within the claim language of independent claims 1 and 11 was the temporal relationship between the time offset estimate determination steps and the adjusting or converting steps, with Applicant arguing that the wording of the claims implied that the adjusting or converting steps were necessarily only performed after the time offset determination step. The Board of Appeals opted to read independent claims 1 and 11 broader than argued by the Applicant, such that the position of the Appeals Board was that the claims could read upon Premierlani because the temporal relationship was not explicitly claimed (see pages 4 and 5 of the Appeals Decision). Accordingly, pursuant to *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc), the Appeals Board

rejected the claims so as not to import an unnecessary reading of the temporal relationship from the Specification into the claims.

Accordingly, to overcome the Appeals Board's particular reading of the claims in this circumstance, Applicant has amended independent claims 1 and 11 to explicitly indicate the order in which the determining step and adjusting or converting steps are performed. Accordingly, independent claim 1 recites "determining, only after the converting step, a time offset estimate..." and independent claim 11 recites "determining, only after the adjusting step, a time offset estimate..." Further, as both the Examiner and the Board of Appeals appear to agree that the timestamp wrap-around compensation of Premierlani is performed only after the round-trip calculation, Applicant respectfully submits that independent claims 1 and 11 as presently recited distinguish from Premierlani at least in view of the presently filed amendments.

Accordingly, claims 2-4, 7, and 10, dependent upon independent claims 1, are likewise allowable over Premierlani at least for the reasons given above with respect to independent claim 1.

Applicant respectfully requests that the Examiner withdraw this art grounds of rejection.

Claim Rejections - 35 U.S.C. 103(a) Premierlani in view of Thornberg

Claims 5-6 and 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Premierlani in view of Thornberg. Applicant respectfully traverses this art grounds of rejection.

The Examiner alleges that "Thornberg teaches calculating a plurality of uplink and downlink delays in order to find a average uplink and downlink delay" (see page 4 of the Final Office Action mailed on December 15, 2004). Applicant respectfully submits that even if Thornberg were to teach this, Thornberg fails to disclose or suggest the deficiencies of Premierlani as discussed above with respect to independent claim 1.

As such, claims 5-6 and 8-10, dependent upon independent claim 1, are likewise allowable over Premerlani in view of Thornberg at least for the reasons given above with respect to independent claim 1.

Applicant respectfully requests that the Examiner withdraw this art grounds of rejection.

Reconsideration and allowance of all pending claims is respectfully requested.

CONCLUSION

In view of the above remarks and amendments, Applicant respectfully submits that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

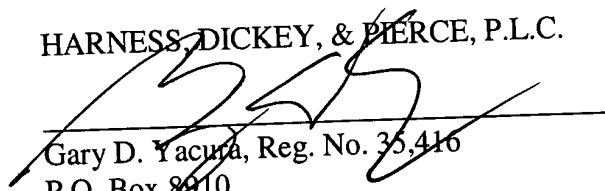
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura, Reg. No. 35,416, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNES, DICKEY, & PIERCE, P.L.C.

By



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